

REMARKS

The Office required restriction in a two-way restriction requirement. The applicants hereby elect the subject matter of Group I (*i.e.* claim 1 and new dependent claims 9-16), with traverse, and cancel without prejudice or disclaimer claims directed to non-elected subject matter (*i.e.* claims 2-8). The applicants respectfully traverse the proposed restriction of claim 1 into eight different claims that would have to be examined in eight different patent applications because legal precedent has established that such a restriction is impermissible.

It has long been held that the Office may not impose a restriction requirement on a single claim. *See In re Watkinson*, 14 USPQ.2d 1407 (Fed. Cir. 1990) citing *In re Weber*, 198 USPQ 328, 332 (CCPA 1978) and *In re Haas*, 198 USPQ 334, 336 (CCPA 1978). The courts have definitively ruled that the statute authorizing restriction practice (*i.e.* 35 U.S.C. § 121) provides no authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. In these cases, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Office to fashion such a rejection. As noted in *In re Weber*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim, no matter how broad, which means no matter how many independently patentable inventions may fall within it.

In re Weber at 334.

Alleging that a particular claim represents multiple “patentably distinct” inventions is a *de facto* rejection of the patentability of the claim because the claim cannot issue as drafted. In this regard the courts noted:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of

claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not effect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim will never be considered on the merits.

The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of fragments would not be described in the specification.

See In re Weber , supra, emphasis added.

Instead of improperly imposing restriction requirement on a given claim, the Office may limit initial examination to a “reasonable number” of species encompassed by the claim (*see 37 C.F.R. § 1.146*). This practice strikes an appropriate balance between administrative concerns of the Office and the clear constitutional and statutory rights of the inventor to claim an invention as it is contemplated. *See MPEP at § 803.02; In re Wolfrum*, 179 USPQ 620 (CCPA 1973); and *In re Kuehl*, 177 USPQ 250 (CCPA 1973). Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution nor does it force an applicant to file multiple divisional applications that are incapable of capturing the intended scope of the application. Here, it should be clear that the added cost of filing and prosecuting eight patent applications does not strike an appropriate balance between the administrative concerns of the Office and the applicants’ statutory rights as inventors.

Accordingly, it is respectfully requested that the Office examine the subject matter of claim 1 as filed and new claims 9-16.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. 532592001900.

Respectfully submitted,



Dated: January 17, 2003

By:

Bruce Grant
Registration No. 47,608

Morrison & Foerster LLP
3811 Valley Centre Drive,
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-7962
Facsimile: (858) 720-5125